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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,090	06/30/2003	Jean-Marie Bernard	004900-195	8126

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EXAMINER

SERGEANT, RABON A

ART UNIT PAPER NUMBER

1711

DATE MAILED: 09/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/608,090

Applicant(s)

BERNARD, JEAN-MARIE

Examiner

Rabon Sergeant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 23-35 and 37-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-35 and 37-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 28, 2006 has been entered.
2. Claims 43, 44, 47, 48 and 49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Within claims 43, 44, and 47, adequate support has not been found for the amended subject matter essentially claiming that the modified stable polyisocyanates are produced from themselves. Claim 43 reads that modified stable polyisocyanates are produced by reacting modified stable polyisocyanates with compounds of formula II; however, these modified stable polyisocyanates have already been produced by reacting compounds of formula II.

Within claims 48 and 49, adequate support has not been found for the optional embodiment where non-isocyanate functional compounds are reacted with the compound of formula (II). As claimed, there is no requirement that the optional compounds that react with the compound of formula (II) be isocyanate functional; however, the examiner has not found adequate support for this embodiment. Applicant's cited passage within the specification has been considered; however, it unclear how it provides support for the claimed reaction of optional

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non-isocyanate reactive compounds with compounds of formula II. For example, the passage within lines 1-12 of page 17 of the specification refers to compounds that have already been modified with compounds of formula II; the passage does not disclose the reaction of non-isocyanate functional compounds. The remaining part of the passage appears to be concerned with mixtures of the compounds as opposed to reaction products produced from the compounds.

3. Claims 48 and 49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

With respect to claims 48 and 49, applicant has failed to provide adequate enablement for the claimed optional embodiment where non-isocyanate functional compounds are reacted with the compound of formula (II). As claimed, there is no requirement that the optional compounds that react with the compound of formula (II) be isocyanate functional; however, applicant has failed to teach how such reactions may proceed. As aforementioned, it is not seen that applicant's cited passage describes the optional embodiment or provides guidance to permit one to conduct the reaction with non-isocyanate reactive compounds without having to resort to undue experimentation. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

4. Claims 23-35 and 37-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Firstly, with respect to claim 23, it is unclear how to interpret the language, “isocyanate functions”, in that it is unclear if the language provides only for free isocyanate groups or also for masked isocyanate groups. The meaning must be clear, since applicant has dependent claims wherein masked isocyanate groups are present. Currently, it is unclear if such masked groups are encompassed by the “isocyanate functions” language. Despite applicant’s response, the position is maintained that it is unclear how to interpret “isocyanate functions”; the passage within the specification, cited by applicant, has been considered; however, the passage does not definitively define the language or clarify the scope of the language. The passage merely discloses that isocyanate groups may be blocked; it does not define the resulting groups as “isocyanate functions”. Furthermore, the argument does not address whether other groups are intended to constitute “isocyanate functions”.

Secondly, with respect to claim 40, applicants’ claimed temperature, “110 0C”, is confusing, since it is not clear that the second “0” is intended to represent the symbol for “degrees”.

Thirdly, with respect to claim 43, it is unclear how to interpret applicant’s amended claim language. The language appears to read that the modified stable polyisocyanates are produced from themselves. It cannot be determined if applicant actually intends to claim that the claimed polyisocyanates are produced by further reacting the modified polyisocyanates of formula I with compounds of formula II.

Fourthly, with respect to claim 46, it is unclear what numerical quantity is represented by the subjective word, “several”.

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Fifthly, the subject matter of claim 47 fails to further limit claim 43, because claim 43 requires the presence of masked groups, whereas the masked groups of claim 47 may be present as an alternative embodiment. Note the use of “and/or” within claim 47.

Lastly, with respect to claim 49, the language, as amended, reads “reaction of having at least three isocyanate a polyisocyanate functions” and cannot be understood.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 23-27, 30, 31, 33-35, 42, 45, 48, 50, 55, 56, and 59 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 419114.

The reference discloses the reaction of polyisocyanates with cyclic carbonates having an isocyanate reactive substituent attached to the ring, and the use of the resulting product within polymers. See abstract and page 3, lines 1-8. Applicant’s argument that the reaction product of the polyisocyanates and cyclic carbonates of the reference fails to correspond to the instant compounds has not been substantiated. Given that the reference discloses the reaction of polyisocyanates and cyclic carbonates that correspond to those of applicant, applicant must provide evidence or a compelling argument that the respective products are different. Applicant’s response fails to satisfy this requirement in that applicant’s argument fails to address the fact that, like applicant’s carbonate compound, the prior art compound contains an active hydrogen group. Since equivalent reactants are considered to be utilized, applicant’s argument is

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insufficient to establish that the respective products are different. Furthermore, the reference discloses that a preferred reactant is a derivative of MDI; these derivatives, such as isocyanurate containing derivatives or polymeric MDI are recognized within the art as having functionalities greater than two.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

  
**RABON SERGENT**  
**PRIMARY EXAMINER**

R. Sergent  
September 14, 2006